

II. Rejections Under 35 U.S.C. § 103(a)

The Office bears the initial burden of establishing a prima facie case of obviousness. In so doing, the Office must demonstrate that some suggestion or motivation existed, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference teaching. M.P.E.P. § 2143. In this case, Applicant respectfully submits that the Office has failed to set forth the necessary evidence to satisfy at least this requirement for each rejection, as discussed in further detail below.

A. Lim in view of Akram

The Office has maintained the rejection of claims 1-3 and 5-18 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 6,074,438 to Lim et al. ("*Lim*") in view of U.S. Patent No. 5,230,710 to Akram et al. ("*Akram*"). Applicants respectfully traverse this rejection for reasons of record, as well as the reasons presented below.

The Office alleges that *Lim* teaches a dyeing composition containing a 2-chloro-4-aminophenol oxidation base and a pyrazolone coupler. *Office Action*, p. 3. The Office notes that *Lim*'s compositions can further contain direct dyes, additional p-aminophenol oxidation bases, and additional couplers such as the claimed 2,6-bis(hydroxyethylamino)toluene. *Id.* In the Office's view, some of these additional oxidation bases are included in the present claims. *Id.* The Office further notes that *Lim* teaches that its compositions can be packaged in kits and can be applied to hair according to a process similar to the present claims. *Id.* The Office does admit, however, that *Lim* does not exemplify a composition, process, or kit which contains the claimed coupler and the claimed oxidation bases. *Id.* The Office relies on *Akram* for its

FINNEGAN  
HENDERSON  
FARABOW  
GARRETT &  
DUNNER LLP

1300 I Street, NW  
Washington, DC 20005  
202.408.4000  
Fax 202.408.4400  
www.finnegan.com

teaching of improved dyeing properties when the presently claimed 2,6-bis(hydroxyethylamino) toluene is used in dye compositions as a coupler. *Id.*

Based on these teachings, the Office sets forth three rationales to support the rejection. First, the Office concludes that it would have been obvious to formulate the claimed composition because *Lim* teaches the individual dye ingredients, the dye process, and the dyeing kits. *Office Action*, pp. 3-4. Second, the Office alleges that based on *Akram*'s favorable teachings of the 2,6-bis(hydroxyethylamino) toluene coupler "those skilled in the art would have been motivated to select the claimed coupler from among those taught by *Lim*." *Id.* at p. 3. Finally, the Office contends that it would have been "obvious to add any or all of the claimed p-aminophenols [as taught by *Lim*]. . . in order to provide a variety of shades to the hair and additionally because it is notoriously well known in the hair dyeing art to combine several oxidation bases and couplers . . . , and the use of . . . additional bases and couplers falls within *Lim*'s express teachings." *Id.* Applicants respectfully submit that the Office's asserted rationales lack sufficient specificity to sustain the rejection.

**1. No Motivation or Suggestion to Combine**

In an attempt to guard against hindsight reconstruction, the Federal Circuit has set a high bar for establishing a prima facie case of obviousness. Accordingly, the Office must provide "clear and particular evidence of a teaching, suggestion, or motivation to combine the reference teachings; broad and conclusory statements will not suffice. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). In this case, the Office has provided no such evidence of the obviousness of the claimed invention and has seemingly appeared to substantiate the rejection solely based on hindsight.

FINNEGAN  
HENDERSON  
FARABOW  
GARRETT &  
DUNNER LLP

1300 I Street, NW  
Washington, DC 20005  
202.408.4000  
Fax 202.408.4400  
www.finnegan.com

First, merely because the Office can demonstrate that individual components of the claimed invention are disclosed by *Lim*, does not, by itself, make out a prima facie case of obviousness. Rather, the law requires that the prior art suggest the desirability of the alleged combination. See M.P.E.P. § 2143.03 (noting that to support a rejection based on a combination of references, the "prior art must suggest the desirability of the combination."). Thus, the Office's reliance on *Lim* is misplaced because nothing in *Lim* suggests the desirability of the claimed invention.

In fact, *Lim*, as the Office admits, primarily touts the advantages of a dyeing composition containing a 2-chloro-4-aminophenol oxidation base and a pyrazolone coupler. Notably, neither one of these components fall within the scope of the oxidation base and coupler recited in the present claims. Thus, in order to substantiate the rejection, the Office relies on *Lim*'s teaching of a laundry list of optional oxidation bases and couplers. See *Lim*, cols. 5-6 (disclosing optional dye components for use in its compositions). Nothing, however, would have motivated one of ordinary skill to select, out of context, the presently claimed oxidation bases and oxidation coupler from this laundry list of optional dye ingredients.

This rationale is not only illogical but overbroad as well. Based on the Office's logic, any dye composition using any ingredient disclosed in *Lim* would have been obvious if combined. However, such a rationale flies in the face of the Federal Circuit's required showing of "clear and particular" evidence of a motivation to combine.

Accordingly, because the Office has presented no evidence demonstrating why one would have arbitrarily selected the claimed components from among the numerous

FINNEGAN  
HENDERSON  
FARABOW  
GARRETT &  
DUNNER LLP

1300 I Street, NW  
Washington, DC 20005  
202.408.4000  
Fax 202.408.4400  
www.finnegan.com

optional components from *Lim* to arrive at the presently claimed invention, Applicant respectfully requests, for at least this reason, that the rejection be withdrawn.

Second, Applicant contends that the Office's reliance on Akram is also misplaced because the Office fails to take into account the prior art as a whole. Although *Akram* does generally disclose substituted 2,6-diaminotoluene couplers, it does not suggest the use of this coupler with substituted p-aminophenols. Even when *Akram* is taken in conjunction with *Lim*, nothing in this combination even implicitly suggests the present invention. Nor has the Office provided any evidence of such a suggestion in the prior art. Thus, Applicants contend that the Office's asserted basis fails to meet the criteria needed to justify a § 103(a) rejection.

Finally, contrary to the Office's allegations, it would not have been obvious to add "any or all the claimed aminophenols" to hair dyeing compositions. The Office's asserted basis for justifying this rationale, i.e. the desire to modify colors and the fact that it is notoriously well-known to combine various dye components, is conclusory and improper. Although it is known to modify color using different types of oxidation bases, as suggested by the Office, many other variables can be used to affect color as well. See, e.g. *The Science of Hair Care*, Charles Zviak, ed., Marcel Dekker, Inc. New York (1986) p. 272 ("Any varying element can cause a major change."). And nothing in the cited references suggest or even imply that this combination would yield a successful and workable hair dye. Thus, the Office has failed to demonstrate why one would select the presently claimed oxidation bases and coupler to modify color or vary shades of color.

FINNEGAN  
HENDERSON  
FARABOW  
GARRETT &  
DUNNER LLP

1300 I Street, NW  
Washington, DC 20005  
202.408.4000  
Fax 202.408.4400  
www.finnegan.com

Indeed, the prior art suggests a contrary result. *Claussen*, another reference cited by the Office, demonstrates that not all components disclosed in *Lim*'s laundry list would result in hair dyes with the desired qualities the present inventors sought. *Claussen* teaches that two of the presently claimed oxidation bases, 4-amino-2-methylphenol and 4-amino-2-hydroxymethylphenol, "provide *comparatively weaker* and bluer shades than the standard p-aminophenol." *Claussen*, col. 5, lines 54-56 (emphasis added). Accordingly, given the fact that the present inventors endeavored to discover "novel hair dyes . . . capable of giving intense, highly chromatic colorations," one skilled in the art would not have chosen these oxidation bases from *Lim*'s disclosure. *Present specification*, lines 6-8. As *Claussen* suggests, these bases would not have been expected to meet the specific requirements the present inventors were seeking.

Thus, given *Lim*'s broad disclosure of oxidation dye components coupled with a preference for other substituted p-aminophenols, the Office's rejection clearly cannot stand. See *In re Baird*, 16 F.3d 380 (Fed. Cir. 1994) (broad generic disclosure of a genus did not render species unpatentable). It appears that the Office has simply taken the position that the combination of known ingredients are *prima facie* obvious. But the law prescribes no such standard. Indeed, the Federal Circuit has recognized that "[m]ost if not all inventions arise from a combination of old elements . . . . However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention." *In re Kotzab*, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000) (internal citations omitted). Accordingly, Applicant respectfully requests that the Office withdraw this improper rejection.

FINNEGAN  
HENDERSON  
FARABOW  
GARRETT &  
DUNNER LLP

1300 I Street, NW  
Washington, DC 20005  
202.408.4000  
Fax 202.408.4400  
www.finnegan.com

**B. Lim in view of Akram and further in view of Claussen**

The Office has further rejected claims 1-3 and 5-18 under 35 U.S.C. § 103(a) as unpatentable over *Lim* in view of *Akram* as applied to claims 1-3 and 5-18, and further in view of U.S. Patent No. 4,997,451 to Clausen et al. ("*Clausen*"). Applicant respectfully traverses this rejection as well.

The Office alleges that *Lim* and *Akram* teach that the "claimed substituted p-aminophenol bases are compatible with the claimed coupler when used in oxidation dyeing compositions and that the claimed coupler has certain advantageous properties . . . ." *Office Action*, p. 7. The Office now relies on *Claussen* to provide motivation to select the presently claimed substituted p-aminophenol bases for use in a hair dyeing composition. *Id.* According to the Office, *Claussen* teaches the use of the presently claimed 4-amino-2-methoxymethylphenol as a preferred embodiment. *Id.* Thus, the Office concludes, that it would have been obvious to select a substituted p-aminophenol for use in an oxidative hair dye composition instead of p-aminophenol because p-aminophenol has poor physiological compatibility and substituted p-aminophenols have outstanding dyeing properties and is a closely related substitute for p-aminophenols. *Id.*

Applicant contends that this rejection is improper because the Office has also failed to consider the *Claussen* reference in its entirety. The M.P.E.P. mandates that "[a] prior art reference must be considered in its entirety, i.e. as a *whole*, including portions that would lead away from the claimed combination. M.P.E.P. § 2141.02 (emphasis in the original). In this case, the *Claussen* reference actually teaches away from the use of other substituted p-aminophenols. As briefly discussed above, *Claussen* states that two of the presently claimed compounds, 4-amino-2-methylphenol

FINNEGAN  
HENDERSON  
FARABOW  
GARRETT &  
DUNNER LLP

1300 I Street, NW  
Washington, DC 20005  
202.408.4000  
Fax 202.408.4400  
www.finnegan.com

and 4-amino-2-hydroxymethylphenol, "provide comparatively weaker and bluer shades that the standard p-aminophenol." *Claussen*, col. 5, lines 54-56. While, in contrast, its claimed 4-aminophenol derivatives provide the same color shades and a comparable color depth as p-aminophenol. *Id.*, lines 57-59.

Moreover, *Claussen* further notes that even structurally similar compounds, such as the presently claimed 4-amino-3-methylphenol results in "considerably reduced color depth" than their claimed 4-aminophenol derivatives. *Id.*, lines 60-63. Thus, contrary to the Office's belief, *Claussen* provides no basis for the use of substituted p-aminophenols. Rather, it specifically teaches a narrow class of 4-aminophenol derivatives and teaches away from the use of other substituted p-aminophenols. Thus, *Claussen* provides no basis for maintaining a § 103(a) rejection because one skilled in the art would have had no motivation to make the proposed modification. Accordingly, Applicant respectfully requests that the Office withdraw the rejection.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: July 8, 2003

By:



Mark D. Sweet  
Reg. No. 41,469

FINNEGAN  
HENDERSON  
FARABOW  
GARRETT &  
DUNNER LLP

555046

1300 I Street, NW  
Washington, DC 20005  
202.408.4000  
Fax 202.408.4400  
www.finnegan.com